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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,896

10/17/2005

Marcus Plummer

UDL-101-US

9659

7590

02/19/2008

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EXAMINER

PAINTER, BRANON C

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

02/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,896	<b>Applicant(s)</b> PLUMMER, MARCUS	
	<b>Examiner</b> BRANON C. PAINTER	<b>Art Unit</b> 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/25/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/25/05 &amp; 12/19/05</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 02/25/05 and 12/19/05 are being considered by the examiner.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: "longitudinal access."  
For the purpose of this examination, the examiner presumes this should read "longitudinal axis." Appropriate correction is required.

Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

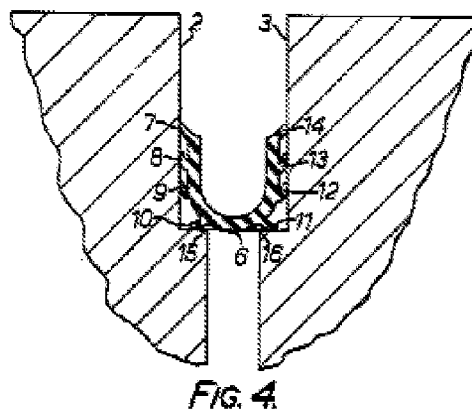
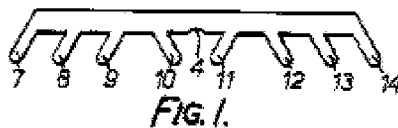
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Halls (GB 1,380,395).
5. Regarding claim 6, Halls discloses two adjacent panels with sealing strip having all of the applicant's claimed structure, including:
  - a. A sealing strip filling a gap between the panels ("sealing strip" 1 between "surfaces" 2, 3, Fig. 1, 4).

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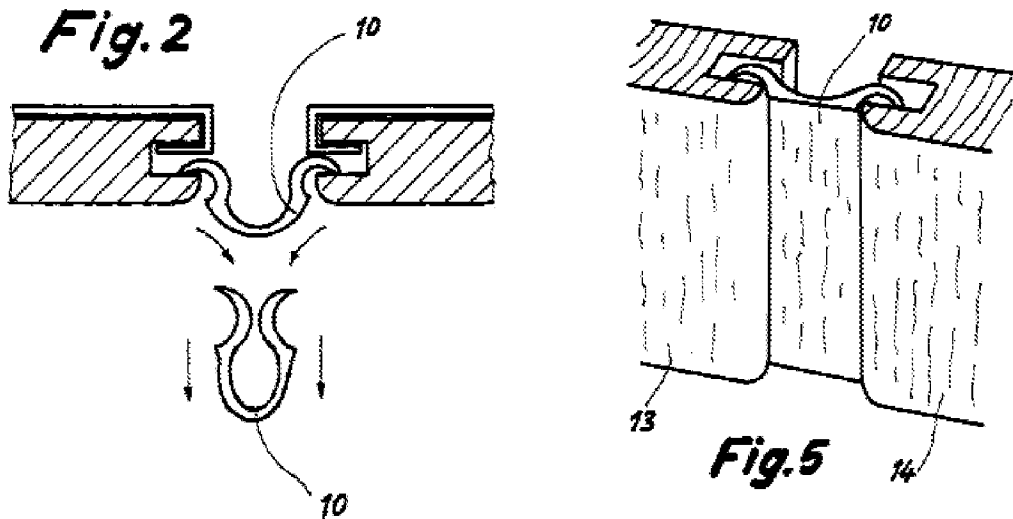
- b. The sealing strip comprising an elongate piece of resiliently flexible plastics material ("sealing strip 1, which is made of a resiliently flexible material such as a polymer or a material including a polymer," lines 87-90). The examiner notes that plastics necessarily include polymers, therefore they are covered by the disclosure of Halls.
- c. The strip being folded about a longitudinally extending line intermediate its opposite side edges and whose sides are biased against the side edges of the respective adjacent panels with the strip inserted completely into the gap between panels ("the strip is resiliently deformable to a generally U-shape with the one face outermost by bending about the central longitudinal axis of the strip and to be positioned in a gap between juxtaposed surfaces," lines 28-33; Fig. 4).



Reproduced from Halls

6. Regarding claim 10, Halls discloses a flat strip with a line of weakness along which the strip is folded (“notch” 4, Fig. 1).
  - a. The examiner notes that claim 10 is considered to be a product-by-process claim due to the phrase “pre-formed.” The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).
7. Regarding claim 1, Hall discloses the claimed method steps set forth in claim 1. Said steps can clearly be seen in Hall’s specification and drawings.
8. Claims 1-2 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bogle (EP 0,940,524 A2 – Derwent Abstract).
9. Regarding claim 6, Bogle discloses two adjacent panels with sealing strip having all of the applicant’s claimed structure, including:
  - a. A sealing strip filling a gap between the panels (“closure” 10 between “boards” 13, 14, Fig. 2, 5).
  - b. The sealing strip comprising an elongate piece of resiliently flexible plastics material (“The joint closure (10) is of plastics,” Derwent Abstract; Fig. 2 demonstrates the resiliency of the strip).
  - c. The strip being folded about a longitudinally extending line intermediate its opposite side edges and whose sides are biased against the side edges of

the respective adjacent panels with the strip inserted completely into the gap between panels (Fig. 2 shows the strip folded along the axis and being inserted into the gap between panels; Fig. 5 shows that the strip lies completely within the thickness of the panels after installation).



Reproduced from Bogle

10. Regarding claim 7, Bogle discloses a strip colored to resemble the panel members ("The joint closure (10)...can be in a color matching the cladding boards," Derwent Abstract; Fig. 5).
11. Regarding claims 1 and 2, Bogle discloses the claimed method steps set forth in claims 1 and 2. Said steps can clearly be seen in Bogle's specification and drawings.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bogle (EP 0,940,524 A2 – Derwent Abstract).

15. Regarding claim 8:

- a. Bogle discloses two adjacent panels with sealing strip as set forth above.
- b. Bogle does not expressly disclose that the strip is transparent.
- c. The examiner further notes that it would have been an obvious matter of design choice to modify the strip by making it transparent, since applicant has not disclosed that transparent strips solve any stated problem or is for any particular purpose and it appears that a strip colored to blend in with the panels would perform equally well in sealing the gap between floorboards.
- d. The examiner notes that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) {see MPEP 2144.04}.

16. Regarding claim 3, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.
17. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halls (GB 1,380,395).
18. Regarding claim 9:
- a. Halls discloses two adjacent panels with sealing strip as set forth above.
  - b. Halls does not expressly disclose that the strip is V-shaped in cross-section.
  - c. The examiner further notes that it would have been an obvious matter of design choice to modify the U-shaped strip of Halls by making it V-shaped, since applicant has not disclosed that a V-shaped strip solves any stated problem or is for any particular purpose and it appears that a U-shaped strip would perform equally well in sealing the gap between floorboards.
  - d. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.
19. Regarding claim 4, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

### **Conclusion**

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is



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(571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./  
Examiner, Art Unit 3633  
02/04/08

/Brian E. Glessner/  
Supervisory Patent Examiner, Art Unit 3633